

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES A. SIMMONS

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Appeal No. 1998-0795  
Application No. 08/482,639

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ON BRIEF

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Before CALVERT, Administrative Patent Judge, McCANDLISH, Senior Administrative Patent Judge, and PATE, Administrative Patent Judge.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 46, 48 and 50 through 58, as amended after the final rejection. Claims 42, 45, 47 and 49, the rejections of which were originally appealed, were canceled in the reply brief.

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Thus, the appealed claims are the only claims remaining in the application.

The claimed invention is directed to an article for providing cushioning during shipping. The article is comprised of multiple plies, one or two plies of which are wrapped around other plies which have been shaped to form a pillow-like product. The claimed subject matter may be further understood with reference to the appealed claims, the independent claims of which are appended to the reply brief and the examiner's supplemental answer.

The reference of record relied upon by the examiner as evidence of anticipation is:

Krueger	5,330,819	Jul. 19,
1994		

#### REJECTIONS

Claims 46 and 54 stand rejected under 35 U.S.C. § 102(b) as anticipated by Krueger.

Claims 48, 50 through 53 and 55 through 58 stand rejected under 35 U.S.C. § 112, first paragraph.

#### OPINION

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We have carefully reviewed these rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the determination that the prior art establishes the lack of novelty of claims 46 and 54. The rejection of these claims under 35 U.S.C. § 102 is affirmed. Furthermore, we have determined that claims 48, 50 through 53, and 55 through 58 have been amended to avoid the rejection under 35 U.S.C. § 112, first paragraph. Accordingly, this rejection is reversed. Our reasons follow.

Turning to claims 46 and 54 on appeal, we must point out that the claims do not require the multiple plies of stock material to be attached or stacked, nor do the claims require all of the plies to be made of the same material. For these reasons, it is our finding that Krueger anticipates claims 46 and 54. Krueger discloses a shell formed from tissue paper, a single ply of stock material. Krueger further shows the inside stuffing being made of shreds of paper in the range of 8 to 12 mm long and 2 to 3 mm wide. It is axiomatic that the shreds of paper of Krueger were at one time plies of stock material before they were shredded. Finally, Krueger teaches closing the pillow-shaped article with a longitudinal fold and

a transverse fold. Appellant argues, in the reply brief, that the tabs of Krueger are not formed by the lateral end sections of the ply. We disagree. As is clearly shown in the Tew patent, referenced by both the appellant and the examiner, a longitudinal seam is placed in the shell before the transverse closings seal the stuffing in the shell body. This is the longitudinal seam shown in the Figure of Krueger. We are in agreement with the examiner that Krueger anticipates claims 46 and 54.

Turning to the rejection of claims 48, 50 through 53, and 55 through 58, we agree with appellant that the amendments made to the independent claims of this group of claims obviate the examiner's ground of rejection under 35 U.S.C. § 112, first paragraph. The claims now specify that the shell is made of one ply or two plies, or at least one ply, of not more than two plies. The specification conveys possession of this subject matter as now claimed. The rejection under 35 U.S.C. § 112, first paragraph, is reversed.

#### SUMMARY

The rejection of claims 46 and 54 under 35 U.S.C. § 102 is affirmed. The rejection of claims 48, 50 through 53, and

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55 through 58 under 35 U.S.C. § 112, first paragraph, is  
reversed.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT

HARRISON E. MCCANDLISH )  
Senior Administrative Patent Judge ) APPEALS

AND

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WILLIAM F. PATE, III  
Administrative Patent Judge

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